

REMARKS

I. Status of the Claims

Claims 17, 37, 53, and 73 are pending. No claims have been amended by this reply.

II. Double Patenting Rejections

A. Statutory Double Patenting

The Examiner provisionally rejected claims 17, 37, 53, and 73 under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 16, 35, 49, and 68 of co-pending Application No. 10/395,064. Office Action at page 2.

Applicants respectfully disagree and traverses this rejection for at least the following reasons.

A statutory double patenting rejection is only proper when the same invention is being claimed. The M.P.E.P. states that if there is an embodiment of the invention that falls within the scope of one claim, but not the other, then identical subject matter is not defined by both claims and statutory double patenting does not exist. M.P.E.P. § 804. The term "same invention" means an invention drawn to identical subject matter. M.P.E.P. § 804; *see In re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970).

The present claims are not drawn to the same invention as co-pending Application No. 10/395,064 because they do not claim identical subject matter. The present claims recite, *inter alia*, an aerosol composition which comprises a liquid phase comprising at least one composition comprising heterogeneous (meth)acrylic copolymer particles, said particles being the same or different. In contrast, the co-pending Application does not claim a composition comprising particles, let alone heterogeneous

(meth)acrylic copolymer particles as recited in the present claims. Therefore, the present claims and the claims of the co-pending application do not have the same scope and a statutory double patenting rejection is improper.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of this rejection.

B. Obviousness-type Double Patenting

The Examiner rejected claims 17, 37, 53, and 73 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claim 9 of U.S. Patent No. 6,689,346 ("US '346") and over claim 11 of U.S. Patent No. 6,645,478 ("US '478"). Office Action at page 3.

The Examiner alleges that "claim 53 has each and every element of the conflicting claims, and claims 17, 37, and 73 disclose genetically [sic] the ingredients that are exemplified by specific species of U.S. '346 and U.S. '478." *Id.* The Examiner goes on to state that "[t]he difference in preamble between the instant claims and that of conflicting patents is that the preamble of the instant claims recites composition comprising heterogeneous particles, while the other two applications recite composition comprising at least one copolymer." *Id.* at page 4.

Applicants respectfully disagree and traverse this rejection for at least the following reasons.

The Examiner has clearly misread the preamble of the present claims. As explained above, the Examiner erroneously believes the preamble of the present claims to be a "composition comprising heterogeneous particles."

The preamble of each of the present claims is "[a]n aerosol device," not "a composition." Furthermore, the term "comprising" is a transition word used between the preamble and the body of the claim and used to define the scope of the claim. See M.P.E.P. § 2111.03; *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 U.S.P.Q.2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.) Thus, anything coming after the term "comprising" is part of the body of the claim and not part of the preamble. Therefore, the recitation of heterogeneous particles is a claim element that cannot be disregarded as the Examiner has done.

Claim 9 of US '346 and claim 11 of US '478 do not claim an aerosol device comprising, *inter alia*, an aerosol composition comprising liquid phase comprising at least one composition comprising heterogeneous (meth)acrylic copolymer particles as recited in each of the present claims. Because US '346 and US '478 do not claim all of the recited claim elements of the present invention, the double patenting rejection of the present claims is improper.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of this rejection.

III. Rejections Under § 102

The Examiner has rejected the present claims under 35 U.S.C. § 102 as allegedly being anticipated by several different references, each of which is independently addressed below.

To anticipate a claim, the reference must teach every element of the claim.

M.P.E.P. § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”).

As explained below, each of the references relied upon by the Examiner fails to disclose each element recited in the claims.

A. U.S. Patent No. 5,662,892

The Examiner has rejected claims 17, 37, 53, and 73 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,662,892 to Bolich, Jr. et al. (“Bolich”). Office Action at page 4.

The Examiner asserts that the composition of Bolich “is in the form of a discontinuous phase of dispersed droplets or particles of the copolymer and a volatile solvent distributed throughout the carrier,” and that because the composition of Bolich is in the form of discontinuous phase of dispersed droplets or particles, “this inherently means that the composition is heterogeneous and reshapable.” Office Action at page 5. Applicants disagree with this assertion for at least the following reasons.

As an initial matter, the Examiner has misinterpreted the disclosure of Bolich to mean that the carrier comprises copolymer particles. This interpretation is not correct because Bolich discloses that the copolymer is *soluble* in the hydrocarbon solvent, and the hydrocarbon solvent is insoluble in the aqueous carrier of the composition. Bolich at col. 6, line 65 to col. 7, line 9. Thus, it is the combination of the copolymer and solvent, in which the copolymer is soluble, that forms the droplets dispersed in the carrier in the

composition of Bolich, and not copolymer particles as the Examiner asserts.

Consequently, the composition of Bolich does not comprise heterogeneous (meth)acrylic copolymer particles as recited in the present claims.

Furthermore, the Examiner's assertion that the composition is inherently heterogeneous and reshapable is completely unsupported by factual or technical evidence. When asserting inherency, it is the Examiner's burden to provide factual and technical grounds establishing that the claimed feature necessarily flows from the teachings of the prior art. M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int.). The burden to rebut shifts to Applicants only after the Examiner has established inherency by presenting these factual and technical grounds. *In re Best*, 195 U.S.P.Q. 430, 433 (C.C.P.A. 1977) (emphasis added).

It is noted that the Examiner asserts "the composition [of Bolich] is heterogeneous." Office Action at page 5. The claims, however, recite "at least one composition comprising heterogeneous (meth)acrylic copolymer particles." Thus, the Examiner's assertion regarding the heterogeneity of the composition of Bolich, even if true, fails to address the limitations recited in the claims because Bolich does not teach a composition comprising heterogeneous (meth)acrylic copolymer particles.

Additionally, the Examiner provides no evidence, either factual or technical, to support the assertion that the composition of Bolich is reshapable. The Examiner merely states that "[s]ince the composition of Bolich is in the form of discontinuous phase of dispersed droplets or particles...this inherently means that the composition is heterogeneous and reshapable." Office Action at page 5. Bolich does not teach or suggest a reshapable composition. Because the Examiner does not provide any

support for the assertion that the composition of Bolich is inherently heterogeneous and reshapable, the Examiner has not met the burden required to establish inherency.

The Examiner further asserts that “being a hair spray [the composition of Bolich] should inherently contain propellant and being [sic] used from a dispenser.” Office Action at page 6. As explained above, it is the Examiner’s burden to show that the claimed feature necessarily flows from the teachings of the prior art. The Examiner has failed to meet that burden because a hair spray does not necessarily require a propellant. Hair spray can be delivered using a pump-type dispenser, which, unlike an aerosol dispenser, does not use a propellant. Hair spray compositions therefore do not necessarily require a propellant, and the Examiner has not met the burden to establish inherency.

Because Bolich neither teaches nor suggests an aerosol device comprising every element recited in the present claims, the Examiner has failed to meet the burden required to establish a *prima facie* case of anticipation.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of this rejection.

B. U.S. Patent No. 6,214,328

The Examiner has rejected claims 17, 37, 53, and 73 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,214,328 to Chang et al. (“Chang”). Office Action at page 6.

The Examiner asserts that “[s]ince Chang utilizes the composition in aerosol form, using propellants...the composition is inherently heterogeneous containing

particles by the virtue of 'aerosol' as suspension of liquid or solid particles well known by those skilled in the art." Office Action at page 7.

It is initially noted that the Examiner's assertion fails to address all the claim limitations. The Examiner asserts that "the composition is inherently heterogeneous containing particles." Office Action at page 7. The present claims, however, recite "at least one composition comprising heterogeneous (meth)acrylic copolymer particles." Thus, the Examiner's assertion regarding the heterogeneity of the composition, even if true, fails to address all of the limitations recited in the claims because Chang does not teach a composition comprising heterogeneous (meth)acrylic copolymer particles.

Furthermore, the fact that Chang teaches an aerosol does not necessarily require the aerosol to comprise heterogeneous (meth)acrylic copolymer particles. The definition of aerosol provided by the Examiner applies to the suspension of droplets or particles in air, e.g., after the composition is dispensed. Nothing in that definition requires the composition of Chang to comprise an aerosol composition comprising a liquid phase comprising at least one composition comprising heterogeneous (meth)acrylic copolymer particles.

In fact, Chang teaches that the composition is an aqueous composition and that the polymers are water-soluble. Chang at col. 1, lines 23-59. Thus, the polymers of Chang are dissolved in the composition and the composition does not comprise a liquid phase comprising at least one composition comprising heterogeneous (meth)acrylic copolymer particles as recited in the present claims.

Furthermore, Chang neither teaches nor suggests that the composition has a reshapable effect. Notably, the Examiner has failed to provide factual or technical

grounds establishing that the compositions disclosed by Chang possess a reshapable effect. Thus, the Examiner has failed to meet the burden required to establish inherency.

Because Chang does not teach every limitation recited in the present claims, Chang cannot anticipate the present claims. Accordingly, Applicants respectfully request the reconsideration and withdrawal of this rejection.

C. U.S. Patent No. 6,689,346

The Examiner rejected claims 17, 37, 53, and 73 under 35 U.S.C. § 102(e) as allegedly being clearly anticipated by U.S. Patent No. 6,689,346 to Rollat et al. ("Rollat").

Rollat, discussed above in the response to the obviousness-type double patenting rejection, does not teach every limitation recited in the present claims. The broad disclosure of Rollat merely indicates that the aerosol composition may comprise polymer particles. Rollat at col. 2, lines 49-51. Rollat, however, does not disclose an aerosol device comprising a composition comprising heterogeneous (meth)acrylic copolymer particles as recited in the present claims.

Accordingly, Applicants submit that Rollat fails to teach each and every limitation recited in the present claims and respectfully request the reconsideration and withdrawal of this rejection.

IV. Conclusion

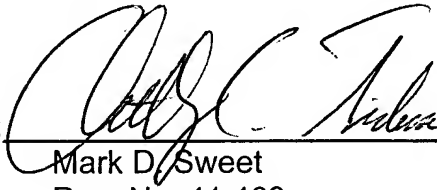
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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